

REMARKS

Claims 8, 10, 12, and 26 have been amended herein. Claims 28-34 have been added. Claims 1-34 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim 8 has been amended to correct a grammatical error.

Claim 10 has been amended to provide antecedent support for “the bottom wall”.

The indication of allowable subject matter is greatly appreciated. Dependent claims 6, 9, 11, 24 and 27 which were indicated in the Action to recite allowable subject matter, have been respectively rewritten as independent claims 28-32. Dependent claims 12 and 26 previously dependent on claims 11 and 24 have been amended to depend from corresponding new independent claims 30 and 31. Thus it is respectfully submitted that new claims 28-32 and dependent claims 12, 14-21 and 26 should be in condition for allowance.

New claims 33 and 34 are independent claims that recite that the movable shaker member (or shaking member) includes a resilient member bounding at least a portion of the interior area of the container. Claims 33 and 34 also recite that the actuator is operative to move the shaker member with a shaking motion operative to cause shaking of deposit items in supporting connection therewith, such that the shaking motion facilitates dispersal and settling of deposited items in the interior area of the container. Support for new claims 33 and 34 is found in the Specification, Drawings, and original claims. Claims 33 and 34 distinguish over the applied art for at least the reasons discussed below with respect to claims 1, 2, and 22.

The Pending Claims Are Not Anticipated or Obvious in View of the Applied Art

Claims 1-4, 7, 8, 10, 13-17, 22, 23, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kosugi, U.S. Publication No. 2002/0079361.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosugi in view of Bowling, U.S. Patent No. 6,292,960.

These rejections are respectfully traversed.

Additional Note

Claims 11 and 12 were indicated in the Action to recite allowable subject matter. Rejected claims 14-17 depend from claims 11 and 12 and therefore also recite allowable subject matter. With the amendment of claim 12 to depend from new claim 30, which is an independent claim including the material features of claim 11, claims 14-17 should now also be allowable.

**The Applied References Do Not Disclose or Suggest
the Features and Relationships Recited in Applicants' Claims**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would

literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

**The Features Recited in Applicants' Claims
Patentably Distinguish Over Kosugi**

In the Action claims 1-4, 7, 8, 10, 13-17, 22, 23, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kosugi. These rejections are respectfully traversed. Applicants response to these rejections is based on the Office's referenced interpretation of Kosugi. Thus, any change in the Office's interpretation of Kosugi shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds that the Kosugi reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features and relationships recited in Applicants' claims patentably distinguish over the Kosugi reference.

Claim 1

Claim 1 is an independent claim which is specifically directed to an apparatus. Applicants respectfully disagree that each of the elements recited in claim 1 is disclosed or suggested in Kosugi. For example, claim 1 recites an automated banking machine that includes:

- a moveable shaker member bounding the interior area of the container;
- an actuator that moves the shaker member to cause shaking of deposit items in supporting connection therewith.

The Action appears to allege that Kosugi discloses these features in paragraphs [0020] and [0023] and in Figure 1. In particular the Action states that Kosugi discusses "a movable shaker member (6), which is bounded to the interior are of the container." and "an actuator, which

drives and moves the shaker thereby causing the deposited items to shake.” Applicants respectfully disagree with these assertions.

Element (6) discussed in paragraph [0020] and shown in Figure 1 of Kosugi is called a “pushing plate 6” which is “arranged in the bill storing box 5 to be driven by, for example, a motor to depress bills or to release the depressed state thereof.” Nowhere does Kosugi disclose or suggest that the pushing plate (6) corresponds to the recited “movable shaker member”. Further nowhere does Kosugi disclose or suggest that its pushing plate ever moves in a manner which causes the recited “shaking of deposit items in supporting connection therewith”. In addition nowhere does Kosugi disclose or suggest that the described “motor” which drives the pushing plate (6) of Kosugi is ever capable of moving the pushing plate in a manner that causes shaking of deposit items.

The pushing plate of Kosugi is designed to depress bills. Nowhere does Kosugi disclose or suggest any type of shaking motion that is included in the process of depressing bills. Further, shaking of bills by the pushing plate (6) would not be inherent in Kosugi. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

In Kosugi, the pushing plate (6) moves horizontally as shown by the “arrows” in Figure 1 to depress bills in the bill storing box (5) by pushing on them. There is no inherent need or requirement for such a horizontal motion to depress the bills, to include any form of shaking action. Pushing on the bills would compact the bills into less space without any need to shake the bills.

Kosugi does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Further the recited elements which are not disclosed in Kosugi would also not be inherent in Kosugi. Hence, Applicants’ claim 1 patentably distinguishes over the Kosugi reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection has been overcome. It follows that claims 2-21 which depend from claim 1 are likewise allowable.

Claim 22

Claim 22 is an independent claim which is specifically directed to an automated banking machine apparatus. Applicants respectfully disagree with the assertions in the Action that each of the elements recited in claim 22 are disclosed or suggested in Kosugi. For example, claim 22 recites an automated banking machine apparatus comprising container removably mounted in a chest portion and adapted to receive cash from a cash acceptor device. Claim 22 recites that the container includes:

- an interior area and a movable shaking member bounding the interior area, and
- an actuator in operative connection with the shaking member.

The Action appears to allege that Kosugi discloses these features in paragraphs [0020] and [0023] and in Figure 1. The Action states that Kosugi discusses “a movable shaker member (6), which is bounded to the interior are of the container.” and “an actuator, which drives and moves the shaker thereby causing the deposited items to shake.”

However, as discussed previously with respect to claim 1, Applicants respectfully disagree that Kosugi discloses or suggest such features. For example, element (6) discussed in paragraph [0020] and shown in Figure 1 of Kosugi is called a “pushing plate 6” which is “arranged in the bill storing box 5 to be driven by, for example, a motor to depress bills or to release the depressed state thereof.” Nowhere does Kosugi disclose or suggest that the pushing plate (6) corresponds to the recited “movable shaker member”. In addition nowhere does Kosugi disclose or suggest that any portion of Kosugi corresponds to an "actuator" that is "in operative connection with the shaker member" inside the container.

The pushing plate of Kosugi is designed to depress bills. Nowhere does Kosugi disclose or suggest any type of shaking motion that is included in the process of depressing bills. Further, shaking of bills by the pushing plate (6) would not be inherent in the operation of Kosugi. Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art, that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

In Kosugi, the pushing plate 6 moves horizontally as shown by the "arrows" in Figure 1 to depress bills in the bill storing box (5) by pushing on them. There is no inherent need or requirement for such a horizontal motion to cause shaking of the bills to depress the bills. Pushing on the bills would compact the bills into less space without any need to shake the bills. Indeed as can be appreciated, Applicants' recited shaking action acts to vertically settle and disperse bills. This is in contrast to Kosugi's bill compressor which compacts bills through horizontal applied force. Thus the "pushing plate" of Kosugi does not correspond to Applicants' recited "movable shaker member".

Kosugi does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Further the recited elements which are not disclosed in Kosugi would also not be inherent in Kosugi. Hence, Applicants' claim 22 patentably distinguishes over the Kosugi reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection has been overcome. It follows that claims 23-27 which depend from claim 22 are likewise allowable.

Claims 2 and 3

Claims 2 and 3 depend from claim 1. Claim 2 recites that the moveable shaker member comprises a resilient member. Claim 3 recites that the moveable shaker member comprises a resilient membrane extending across a lower portion of the container. Contrary to the assertions in the Action, nowhere does Figure 1 of Kosugi disclose or suggest a resilient member or a resilient membrane that extending across a lower portion of the container. For example the Action appears to allege that the pushing plate (6) corresponds to the recited "moveable shaker member. Applicants disagree that the pushing plate (6) is a moveable shaker member. However,

even if the pushing plate could be a shaker member (which it is not) nowhere does Kosugi disclose or suggest that its pushing plate comprises either a resilient member or a resilient membrane. As discussed in paragraph [0020] the pushing plate (6) is a plate which is driven by a motor to depress bills. Such a design does not disclose, suggest, or inherently require any resilient member or resilient membrane.

As nothing in the applied art discloses or suggests these recited features and relationships, it is respectfully submitted that the rejections of claim 2 and 3 should be withdrawn.

Claim 7

Claim 7 depends from claim 3 and further recites that the apparatus further comprises a rigid plate extending in underlying relation of the membrane. The actuator operates to move the rigid plate.

Nowhere does Kosugi disclose or suggest these recited features. Although in Figure 1 of Kosugi, the "pushing plate" 6 could arguably correspond to a rigid plate, where is the recited membrane for which the pushing plate extends in underlying relation? Nowhere does Kosugi disclose or suggest a shaker member which comprises a resilient membrane extending across a lower portion of a container and comprises a rigid plate extending in underlying relation of the membrane.

As nothing in the applied art discloses or suggests these recited features and relationships, it is respectfully submitted that the rejection of claim should be withdrawn.

Claim 8

Claim 8 depends from claim 7 and further recites that the container further comprises a bottom wall underlying the membrane, and wherein the actuator extends in intermediate relation of the membrane and the bottom wall.

The Action asserts with respect to paragraph [0022] of Kosugi, it is clear that the actuator must extend in intermediate relation of the bottom wall and the membrane. Applicants respectfully disagree. Kosugi does not disclose or suggest a bottom wall of a container that underlies a resilient membrane of a shaker member, Further Kosugi does not disclose or suggest an actuator that extends in intermediate relation of the of the shaker member membrane and the bottom wall of a container. Further such features would not be inherent in Kosugi. For example, the pushing plate (6) of Kosugi could be driven by worm gear driving mechanism attached to the side of the pushing plate (6). Nothing in Kosugi requires an actuator to be located between a bottom wall of a bill storage box (5) and the pushing plate (6). Further noting in Kosugi requires an actuator to be located between a bottom wall of a container and a resilient membrane of a shaker member.

As nothing in the applied art discloses or suggests these recited features and relationships, it is respectfully submitted that the rejection of claim 8 should be withdrawn.

Claim 10

Claim 10 depends from claim 3 and further recites that the container comprises a bottom wall underlying the membrane. Also claim 10 recites that the container includes an upper wall generally opposed of the bottom wall, the upper wall including an upper wall opening. In

addition, claim 10 recites that deposit items entering the interior area pass through the upper wall opening.

Kosugi does not disclose or suggest an upper wall opening in its bill storage box (5) through which bills pass. Rather Figure 1 of Kosugi shows that bills are moved along passage path (2) to the front side of the bill storage box (5) adjacent gate (8) to move into the bill storage box (Paragraph [0023]). Nowhere does Kosugi show bills passing through an upper wall opening into a bill storage box (5).

As nothing in the applied art discloses or suggests these recited features and relationships, it is respectfully submitted that the rejection of claim 10 should be withdrawn.

**The Pending Claims Are Not Obvious Over
Kosugi in view of Bowling**

In the Action claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosugi in view of bowling. This rejection is respectfully traversed. Applicant's response to these rejections is based on the Office's referenced interpretations of Kosugi and Bowling. Thus, any change in the Office's interpretation of these references shall constitute a new ground of rejection.

Claim 5 depends from claim 4 and recites that the container further comprises at least one rollable support. The Action admits that Kosugi fails to teach the container including a rollable support. However, the Action asserts that Bowling illustrates drawers (4a) which have rollers (72) and that it would have been obvious to use a rollable support as taught by Bowling to remove the container taught by Kosugi.

Applicant respectfully disagrees. Bowling is directed to lockable drawers (30) of a concealed safe (10) designed to support a mattress (12) (Figures 1-2; Column 3, line 51 to

column 4, line 16). Such lockable drawers can be used to hide valuables such as firearms (Abstract). Bowling is non-analogous art to the claimed automated banking machine apparatus. One skilled in the art of automated banking machines would not be aware of or have any reason to look to the art of hiding firearms under a mattress to modify portions of an automated banking machine. The applied art provides no reason to modify the bill storage box (50) of Kosugi to include a rollable support. Kosugi has no need for and would obtain no benefit from a rollable support. In addition nowhere does the applied art show a container including both a movable shaker member and a rollable support.

The Office has not established *prima facie* obviousness with respect to claim 5, and it is respectfully submitted the rejection should be reversed.

Additional Claim Fees

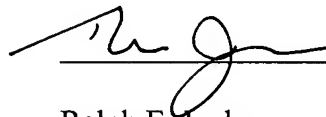
Please charge the fees associated with prosecution of seven additional independent claims in excess of 3 (\$1400) and seven additional total claims (\$350) and any other fee due, to Deposit Account No. 09-0428 of Diebold Self-Service Systems.

Conclusion

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Jocke', is written over a horizontal line.

Ralph E. Jocke Reg. No. 31,029
231 South Broadway
Medina, Ohio 44256
(330) 722-5143